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The opinion in support of the decision being entered
today
and
(1) was not written for publication in a law journal
(2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. COLE
and DAVID M. KOZY

Appeal No. 1997-3997
Application 08/559,117

ON BRIEF

Before JERRY SMITH, FLEMING and BARRY, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

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DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-14, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for applying a predetermined proof load to a cable under test and measuring a resultant cable length.

Representative claim 1 is reproduced as follows:

1. Apparatus for applying a predetermined proof load to a cable under test and measuring the resultant cable length comprising:

means for fixing one end of the cable at a predetermined position;

means for attaching the free end of the cable to an actuator controlled fixture;

means for positioning said actuator controlled fixture at a home position, which home position is a predetermined distance, L_1 , from said fixed position;

load sensor means for sensing the loading on the cable;

controller means for:

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a) controllably actuating said actuator to apply a predetermined loading to said cable;

b) determining a distance, L_2 of said actuator controlled fixture from said home position; and

c) summing said distances L_1 and L_2 to thereby calculate the resultant cable length L .

The examiner relies on the following reference:

Bonine	4,562,743	Jan. 7, 1986.
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Claims 1-14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Bonine taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's

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rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-14. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley

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Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),
cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta
Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,
664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS
Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221
USPQ 929, 933 (Fed. Cir. 1984). These showings by the
examiner are an essential part of complying with the burden of
presenting a prima facie case of obviousness. Note In re
Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.
1992). If that burden is met, the burden then shifts to the
applicants to overcome the prima facie case with argument
and/or evidence. Obviousness is then determined on the basis
of the evidence as a whole and the relative persuasiveness of
the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039,
228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d
1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re
Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).
Only those arguments actually made by appellants have been
considered in this decision. Arguments which appellants could
have made but chose not to make in the brief have not been
considered [see 37 CFR § 1.192(a)].

With respect to independent claims 1 and 8, the examiner cites Bonine as teaching a device for measuring cable elongation or relaxation as a result of forces acting on the cable. The examiner acknowledges, however, that Bonine fails to teach any method for determining lengths L1 and L2 [final rejection]. The examiner also acknowledges that Bonine does not disclose various specific structural details of the claims as argued by appellants in the brief [answer, pages 4-5].

With respect to each of the acknowledged differences between the invention of claims 1 and 8 and the teachings of Bonine, the examiner finds that each of these differences would have been obvious to the skilled artisan [id.].

Appellants point to each of the structural differences between claims 1 and 8 and the teachings of Bonine and argue that the examiner has simply dismissed all the differences between the claimed invention and the teachings of the prior art as obvious within the meaning of 35 U.S.C. § 103 without any teaching or suggestion within the applied references [brief, pages 7-9].

Appellants argue that the examiner's rejection is simply not

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supported by the teachings or suggestions of Bonine.

We essentially agree with appellants' positions as set forth in the brief. Although the examiner's rejection attempts to find rationales for modifying the applied prior art, these rationales are all based on achieving appellants' invention rather than on a suggestion coming from the prior art. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We agree with appellants that the only suggestion on this record for modifying the device of Bonine in the manner proposed by the examiner comes from appellants' own specification.

Since the applied prior art and the examiner's analysis do not establish a prima facie case of the obviousness of the claimed invention, we do not sustain the examiner's rejection of independent claims 1 and 8 based on Bonine taken alone. Since

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the remaining claims all depend from claim 1 or claim 8, we
also do not sustain the rejection of claims 2-7 and 9-14.
Therefore, the decision of the examiner rejecting claims 1-14
is reversed.

REVERSED

Jerry Smith)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Michael R. Fleming)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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